

REMARKS/ARGUMENTS

Priority

In the Reply with Amendment Under 37 U.S.C. § 1.111 filed January 8, 2004, applicants requested acknowledgment of the priority claim. As explained in that Reply, the instant application is the national stage of International Application PCT/EP00/05547 (WO 00/78735) filed on June 16, 2000, which claims benefit to prior U.S. Provisional Application 60/146,644, filed July 30, 1999 and prior German Application Nos. DE 199 28 281 and DE 100 23 085, filed June 21, 1999 and May 11, 2000, respectively. Benefit of the earlier filing date of the prior International Application was claimed pursuant to 35 U.S.C. §365(c) on the Declaration for Utility or Design Application, filed on April 25, 2002. In the Office Action mailed April 23, 2004, the Examiner noted that the file was missing certified copies of both the German applications. The priority documents were submitted on October 21, 2004. A copy of the return post card date stamped on October 25, 2004 is enclosed. Applicants submit that the priority is in order and respectfully requests acknowledgment of the priority claim.

Obviousness-type Double Patenting Rejection

In the communication mailed October 12, 2005, the Examiner has withdrawn an obviousness-type double patenting rejection based on 6,627,634. However, the Examiner has maintained a provisional double patenting rejection based on a copending application 10/023,099 ("the '099 application"). Applicants would like to respectfully draw the Examiner attention to the Declaration of Frank Himmelsbach signed on 8 April, 2004 submitted in the copending '099 application. In view of this 1.132 declaration, the Examiner has already removed the obviousness-type rejection in copending application '099. Furthermore, applicants note that "where, through no fault of the applicant, the claims in a later filed application issue first, an obvious-type double patenting rejection is improper, in the absence of a two-way obviousness determination, because the applicant does not have complete control over the rate of progress of a patent application through the Office." See MPEP §804 citing *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir 1991). In view of the foregoing, it is respectfully submitted that the obviousness-type

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Amdt dated March 13, 2006
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double patenting rejection should similarly be withdrawn in the instant application since a two-way obviousness determination cannot be met for the pending claims of this application. Accordingly, no terminal disclaimer is warranted.

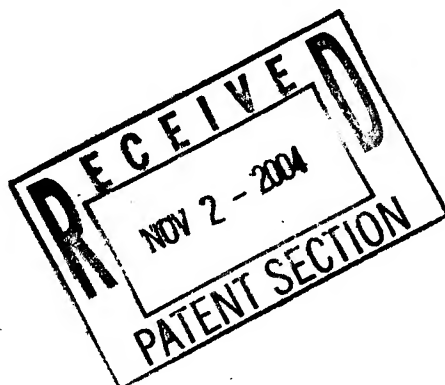
In view of the foregoing, it is respectfully submitted that the subject application is in condition for allowance and such favorable action at an early date is earnestly solicited.

Respectfully submitted,

/Paula K. Wittmayer/

Paula K. Wittmayer
Attorney for Applicant(s)
Reg. No. 53,785

Patent Department
Boehringer Ingelheim Corp.
900 Ridgebury Road
P.O. Box 368
Ridgefield, CT. 06877
Tel.: (203) 791-6692
Fax: (203) 798-4408
Dated: March 13, 2006



5/1262 ✓

S/K

APPLICANT(S): Himmelsbach, et al
SERIAL NO.: 10/016,280
FILING DATE: December 10, 2001
DOCKET NO.: 5/1262
TITLE: Bicyclic heterocycles, pharmaceutical compositions containing these compounds, their use and processes for preparing them

IN CONNECTION WITH THE ABOVE CASE, PLEASE DATE STAMP TO ACKNOWLEDGE RECEIPT OF THE DOCUMENTS LISTED BELOW, AND RETURN TO ADDRESSEE.

1. Reply after Final with Amendment (16 pages)
2. Notice of Appeal (1 page in triplicate)
3. Petition for Extension of Time (1 page in triplicate)
4. Priority Document #199 28 281.1 and #100 23 085.7

Mailed: October 21, 2004

